

REMARKS

The Official Action dated April 24, 2002 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 1, 7, 13 and 21 have been amended to further define the present invention. Attached hereto is "**Version With Markings To Show Changes Made**" showing the changes made to the claims with the current amendment. Since these changes do not involve any introduction of new matter and do not raise any new issues after final rejection, entry is believed to be in order and is respectfully requested.

In the Official Action, claims 1, 2 and 6-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Stephenson (U.S. Patent No. 5,949,469). The Examiner asserted that Stephenson teaches a photoprinter configuration comprising: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via communication link, the photoprinter being operative to control the viewable display of the digital camera.

However, as will be set forth in detail below, it is submitted that the photoprinter configurations and methods for controlling a digital camera defined by claims 1, 2 and 6-12 are not anticipated by Stephenson. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to a photoprinter configuration. The configuration comprises: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a

communication link, the photoprinter being operative to control the viewable display of the digital camera, wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link; and wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media.

As defined by claim 7, the present invention is directed toward a method for controlling a digital camera. The method comprises the steps of: obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operable to print digital photographs onto printable media, wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable media, and further wherein the printable media excludes light-sensitive media; obtaining a digital camera comprising a viewable display and one or more selection mechanisms; connecting the digital camera to the photoprinter via a communication link, wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link; transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and controlling the digital camera by the photoprinter in accordance with the plurality of instructions.

Stephenson discloses an apparatus for exposing light-sensitive photographic media from a liquid crystal display included within an image capture device. The liquid crystal display comprises a source of fluorescent light which includes phosphors. Stephenson also discloses a printer apparatus which includes photo-sensitive media which is adapted to be illuminated by the light emitted from the liquid crystal display, wherein the printer makes a light tight seal around the liquid crystal display in order for the light-sensitive media to be exposed by the liquid crystal display.

In the Official Action, the Examiner asserted that Stephenson teaches a photoprinter configuration comprising a photoprinter capable of processing and printing digital files independent of an external host device. However, Applicants find no teachings, suggestion or disclosure in Stephenson relating to printer configurations and methods for controlling a digital camera comprising a photoprinter capable of processing and printing digital files independent of an external host device, wherein processing digital files comprises calculating a pixel pattern to be printed on the printable media, and further wherein the printable media excludes light-sensitive media.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). When the printer apparatus of Stephenson is connected to the imaging device of Stephenson, the printer creates a light-tight storage structure which is secured over the camera display and thus prevents the camera display from being viewed when the printer is connected to the imaging device. Under the present invention, the photoprinter configuration requires a digital camera comprising a viewable display, wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link. As Applicants find no teaching by Stephenson relating to photoprinter configurations comprising the viewable display of the digital camera being visible when the photoprinter is connected to the digital camera via the communication link and a photoprinter capable of processing and printing digital files independent of an external host device, wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media, Stephenson does not anticipate claims 1, 2 and 6-12 under 35 U.S.C. §102.

It is therefore submitted that the presently claimed printer configurations and methods are not anticipated by Stephenson, whereby the rejection under 35 U.S.C. §102(e) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stephenson. The Examiner noted that Stephenson fails to teach the communication link as a universal serial bus and that Stephenson fails to explicitly teach using an open operating system. The Examiner has taken official notice that it is well-known in the art of photo printing to use a universal serial bus between a photoprinter and a digital camera. The Examiner has further asserted that it is well-known in the art of digital cameras to use an open operating system. The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system as taught by Stephenson with a universal serial bus. Furthermore, the Examiner asserted it would have been obvious to one of ordinary skill at the time of the invention to provide the camera as taught by Stephenson with an open operating system.

However, as will be set forth in detail below, it is submitted that the photoprinter configurations of claims 3 and 5 are non-obvious and patentably distinguishable from the teachings of Stephenson. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 3, the present invention is directed toward a photoprinter configuration of claim 1, further comprising the communication link being a universal serial bus. As defined by claim 5, the present invention is directed toward a photoprinter configuration of claim 1, further comprising the digital camera being an open operating system.

As noted above, Stephenson fails to teach or suggest a photoprinter configuration comprising a photoprinter capable of processing and printing digital files independent of

external host wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media. In addition, Stephenson fails to teach or suggest a photoprinter configuration wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via a communication link.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (C.C.P.A. 1979). Applicants find no teaching or suggestion by Stephenson of a photoprinter configuration comprising a photoprinter capable of processing and printing digital files independent of an external host device wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media, and a digital camera comprising a viewable display, wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link.

Furthermore, to establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In view of the failure of Stephenson to teach, disclose or suggest a photoprinter configuration comprising a digital camera with a visible display when the photoprinter is connected to the digital camera via the communication link and a photoprinter capable of processing and printing digital files independent of an external host device wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium and further wherein the printable medium excludes light-sensitive media, Stephenson does not render the presently claimed photoprinter configurations obvious. It is therefore submitted that the presently claimed photoprinter configurations are

non-obvious over and patentably distinguishable from Stephenson whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Moreover, if an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As claims 3 and 5 depend from and incorporate all of the limitations of claim 1, it is respectfully submitted that claims 3 and 5 are non-obvious over and patentably distinguishable from Stephenson, whereby the rejection under 35 U.S.C. §103(a) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Stephenson in further view of Hanada (U.S. Patent No. 6,000,864). The Examiner noted that Stephenson teaches using a communication link between the camera and the printer. The Examiner noted that Stephenson failed to teach using a wireless communication link. The Examiner asserted that Hanada teaches that it is well-known in the art to transmit data between a digital camera and a printer using wireless means. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at that time the invention was made to provide the apparatus of Stephenson with means to transmit data wirelessly.

However, as will be set forth in detail below, it is submitted that the photoprinter configuration of claim 4 is non-obvious and patentably distinguishable from the teachings of Stephenson in view of Hanada.

As defined by claim 4, the present invention is directed to a photoprinter configuration of claim 1, further comprising the communication link being wireless.

As noted above, Stephenson fails to teach or suggest a photoprinter configuration comprising, *inter alia*, a photoprinter capable of processing and printing digital files independent of an external host device, wherein processing the digital files comprises

calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media; and a digital camera comprising a viewable display wherein the viewable display of the digital camera is visible when a photoprinter is connected to the digital camera via the communication link. The deficiencies of Stephenson as discussed above with respect to independent claim 1 are not resolved by Hanada. That is, despite Hanada's teaching of transmitting print data between a digital camera and a printer via wireless communication, Applicants find no teaching or suggestion by Stephenson alone or in combination with Hanada of a photoprinter configuration comprising, *inter alia*, a digital camera comprising a viewable display wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link, and a photoprinter capable of processing and printing digital files independent of an external host device, wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media.

To establish *prima facie* obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. In view of the failure of Stephenson and Hanada, alone or in combination, to teach, disclose, or suggest photoprinter configurations comprising, *inter alia*, a photoprinter capable of processing and printing digital files independent of an external host device wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media; and a digital camera comprising a viewable display wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link, the combination of Stephenson and Hanada does not support a rejection under 35 U.S.C. §103.

It is therefore submitted that the presently claimed photoprinter configuration is non-obvious over and patentably distinguishable from Stephenson in view of Hanada, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claims 13-23 were rejected under 35 U.S.C. §103 as being unpatentable over Stephenson in view of Taniguchi et al. (U.S. Patent No. 5,999,707). The Examiner notes that Stephenson fails to teach the printer being operable as a client to a host computer. The Examiner asserts that Taniguchi teaches that it is well-known in the art to make a printer operate as a client to a host computer. The Examiner asserted that therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system taught by Stephenson with a host in allowing the printer to operate as a host to the printer.

However, as will be set forth in detail below, it is submitted that the printer configurations of claims 13-23 are non-obvious and patentably distinguishable from the teachings of Stephenson in further view of Taniguchi et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 13, the present invention is directed to a printer configuration. The configuration comprises a host computer; a peripheral device; and a stand-alone printer connected via a communication link to the host computer and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass-through device such that the host may initiate requests to the peripheral device; wherein the stand-alone printer is capable of processing and printing digital files independent of the host computer, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, wherein the printable medium excludes light-sensitive media.

As defined by claim 21, the present invention is directed to a printer configuration. The configuration comprises a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, said peripheral device being subordinated to the stand-alone printer; wherein the stand-alone printer is capable of processing and printing digital files independent of an external host device, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, wherein the printable medium excludes light-sensitive media.

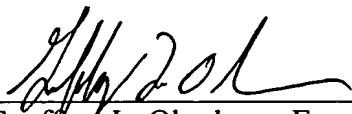
As discussed above, Stephenson fails to teach or suggest a printer configuration comprising, *inter alia*, a stand-alone printer capable of processing and printing digital files independent of an external host device and wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, wherein the printable medium excludes light-sensitive media. Taniguchi et al. does not resolve deficiencies of Stephenson regarding a stand-alone printer capable of processing and printing digital files independent of the external host device, wherein processing the digital files comprises calculating a pixel file to be printed on a printable medium, wherein the printable medium excludes light-sensitive media. Moreover, Applicants find no teaching or suggestion by Stephenson or Taniguchi et al. of a printer configuration comprising a stand-alone printer connected via communication link to the host computer and the peripheral device wherein the stand-alone printer is operable as a host for the peripheral device. The Examiner has identified that Taniguchi et al. teach that it is well-known in the art to make a printer operate as a client to the host computer. However, the Examiner has made no showing or teaching of a printer operating as a host for a peripheral device.

To establish *prima facie* obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. In view of the

failure of Stephenson and Taniguchi et al., alone or in combination, to teach, disclose or suggest printer configurations comprising, *inter alia*, a stand-alone printer connected via communication link to a host computer wherein the stand-alone printer is capable of processing and printing digital files independent of the host computer and wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable medium, wherein the printable medium excludes light-sensitive media; and wherein the stand-alone printer is operable as a host for a peripheral device, the combination of Stephenson and Taniguchi et al. does not support a rejection under 35 U.S.C. §103. It is therefore submitted that the presently claimed printer configurations are non-obvious over and patentably distinguishable from Stephenson in view of Taniguchi et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present the application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,



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VERSION WITH MARKINGS SHOWING CHANGES MADE

In the Claims:

Please amend claims 1, 7, 13 and 21 as follows:

1. (Twice Amended) A photoprinter configuration, comprising:
 - a) a digital camera comprising a viewable display and one or more selection mechanisms; and
 - b) a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera[.], wherein the viewable display of the digital camera is visible when the photoprinter is connected to the digital camera via the communication link;
wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, and further wherein the printable medium excludes light-sensitive media.

7. (Twice Amended) A method for controlling a digital camera, comprising the steps of:
 - a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media[;], wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable media, and further wherein the printable media excludes light-sensitive media;
 - b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms;

c) connecting the digital camera to the photoprinter via a communication link[;],
wherein the viewable display of the digital camera is visible when the photoprinter is
connected to the digital camera via the communication link;

d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and

e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.

13. (Amended) A printer configuration, comprising:

a) a host computer;

b) a peripheral device; and

c) a stand-alone printer connected via a communication link to the host computer

and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass through device such that the host computer may initiate requests to the peripheral device[.];

wherein the stand-alone printer is capable of processing and printing digital files independent of the host computer, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, wherein the printable medium excludes light-sensitive media.

21. (Amended) A printer configuration, comprising:

a) a universal serial bus;

b) a stand-alone printer connected to the universal serial bus as a universal serial bus host; and

c) a peripheral device connected to the universal serial bus as a universal serial bus device, said peripheral device being subordinate to the stand-alone printer[.];

wherein the stand-alone printer is capable of processing and printing digital files independent of an external host device, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium, wherein the printable medium excludes light-sensitive media.